

Serial No.: 09/803,545
Paper Dated February 20, 2007
Reply to Official Actions of September 19, 2006 and January 16, 2007

REMARKS

Status of Claims

Claims 179-210 and 212-220 remain pending. Claims 179 and 198 have been amended.

Applicants' Request for Reconsideration and Advisory Action

On December 15, 2006, Applicants submitted a request for reconsideration of the Examiner's final rejection of the claims then pending in the this application, which rejection was set forth in the Official Action mailed on September 19, 2006. Included in the Applicants' request for reconsideration were proposed amendments to the claims, as well as remarks directed toward the Examiner's §103 rejections and Official Notice taken with respect to certain claim elements.

In an Advisory Action mailed on January 16, 2007, the Examiner declined to consider the amended claims inasmuch as, in the Examiner's view, the amendments would at least require further searching. Without conceding to the Examiner's characterizations, and in an effort to expedite the prosecution of this application, Applicants submit herewith a Request for Continued Examination.

Rejections Under 35 USC § 103

Claims 179-210 and 212-220 stand rejected as being unpatentable over United States Application Publication No. 2001/0044743 to McKinley (hereinafter "McKinley") in view of LetsTalk.com (hereinafter "LetsTalk"). Without conceding to the Examiner's characterizations, and in view of the amendments to independent claims 179 and 198, Applicants respectfully

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traverse this rejection and respectfully request reconsideration of the subject application for at least the following reasons.

Turning now to the specifics of the Examiner's obviousness rejections, 35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Hence, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure *re Vaeck*, 947 F2d 488, 20 USPQ2d 1438 (Fed. Cir. 1999).

Applicant respectfully submits that the cited references, either separately or in combination, fail to either teach or suggest at least each of the limitations of Claims 179-210 and 212-220.

Specifically, the Examiner has rejected independent claims 179 and 198 under 35 U.S.C. §103(a) as being unpatentable over McKinley in view of LetsTalk. In this regard, the Examiner has, in part, characterized McKinley as disclosing "receiving a geographic location via the area

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code and phone exchange." In contrast, Applicants' invention is capable of receiving a geographic location at any level of detail street address or subdivision of a street address.

By way of clarification, Applicants have amended Claims 179 and 198 to recite:

receiving from said user:

(a) said geographic location of said property wherein said geographic location may be identified as specifically as a street address or a subdivision of a street address

Neither McKinley nor LetsTalk teach or suggest, either individually or in combination, "receiving a geographic location identified as specifically as a street address or subdivision thereof." Thus, McKinley and LetsTalk each fail to disclose a system which may receive geographic data related to the property in question at the level of granularity which Applicants' system is able to accept.

Accordingly, Applicants submit that each of independent claims 179 and 198 are patentable over McKinley in view of LetsTalk. In this regard, Applicants respectfully request reconsideration of the Examiner's rejection of independent claims 179 and 198 under 35 U.S.C. §103 (a).

In addition, because Claims 180-197 each depends either directly or indirectly from independent Claim 179, and further because Claims 199-220 depend either directly or indirectly from independent Claim 198, the Examiner's rejections of Claims 180-197 and 199-220 are now considered moot in view of the allowability of independent claims 179 and 198, discussed above. Accordingly, the McKinley and LetsTalk references, either taken alone or in combination, fail to render the invention as claimed in Claims 180-197 and 199-220 unpatentable for obviousness.

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under 35 U.S.C §103 (a). Applicants, therefore, respectfully request reconsideration of the Examiner's rejections of Claims 180-197 and 199-220 under 35 U.S.C. §103 (a).

Official Notice

In addition to the foregoing, the Examiner has rejected, under 35 U.S.C. §103 (a), certain of the dependent claims now pending in this application, in part, based upon the Examiner taking "Official Notice" of certain claimed elements. For the reasons set forth below, Applicants respectfully traverse each of the Examiner's findings in connection with which Official Notice has been taken.

In each of the three instances in which the Examiner takes Official Notice, the Examiner merely concludes that the fact is "notoriously old and well known in the art" without specifically referencing at least some form of evidence to support the Examiner's factual assertions. "Ordinarily, there must be some form of evidence in the record to suggest an assertion of common knowledge." MPEP §2144.03; see *Lee*, 277 F. 3d at 1344045, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F. 3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

In addition, "official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP §2144.03. "It would *not* be appropriate for the examiner to take official notice of facts without

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citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." *Id.* (Emphasis in original). Finally, "if official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable." *Id.* In this regard, and in view of the remarks which follow, Applicants' respectfully submit that the Examiner cannot rely upon the Official Notice of the facts taken in the Official Action without supporting objective evidence.

Turning to the specifics of the Examiner's taking of Official Notice, the Examiner has rejected Claims 184, 185, 203 and 204 under 35 U.S.C. §103 (a) based upon McKinley in view of LetsTalk, and further in view of Official Notice being taken that "it is notoriously old and well known in the art to allow a user to manage his account enabling him to pay for the service." In this regard, the Examiner has not offered any objective support by way of prior art which would teach or suggest the account management functionality which is disclosed and claimed as part of Applicants' invention.

Similarly, the Examiner has rejected Claims 191 and 208 under 35 U.S.C. §103 (a) based upon McKinley in view of LetsTalk, and further in view of Official Notice being taken that it is notoriously old and well known in the art to provide "an account for providing customization elements." Although the Examiner makes reference to the Tobin reference, the Examiner does not specify where in Tobin such an account is recited.

Moreover, Claims 191 and 208 recite "providing brand partners with an account through which said brand partners may provide one or more customization elements or customer accounts." Again, the Examiner does not specifically cite to any prior art which discloses the

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limitations recited in Claims 191 and 208 in support of taking Official Notice of such claim limitations.

Finally, the Examiner has rejected Claims 192 and 209 under 35 U.S.C. §103 (a) based upon McKinley in view of LetsTalk, and further in view of Official Notice being taken that it is notoriously old and well known in the art to provide "an account for tracking usage." Again, the Examiner fails to reference any evidence in the record to support the assertion of Official Notice.

In addition, Claims 192 and 209 recite "providing brand partners with an account through which said brand partners may track usage of said automated method." Again, the Examiner does not cite to any prior art which disclose the limitations recited in Claims 192 and 209 in support of taking Official Notice of such claim limitations.

In view of the foregoing, Applicants respectfully traverse the Examiner's taking of Official Notice of the claim limitations set forth in the pending claims. Accordingly, and in the event that the Examiner maintains his rejections based upon Official Notice, Applicants respectfully request that the Examiner produce authority in the form of documentary evidence for the taking of Official Notice in each instance set forth in the Official Action. *See MPEP §2144.03.*

Request for Reconsideration

In view of the foregoing, Applicants respectfully request that the Examiner reconsider his rejections of the claims now pending and permit the subject application to proceed to allowance.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This

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discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

Request for Personal Interview

In addition, and to the extent that the Examiner maintains his rejections, Applicants respectfully request the courtesy of a personal interview with the Examiner at the earliest possible time.

CONCLUSION

Wherefore, Applicants believe that all outstanding grounds raised by the Examiner have been addressed and respectfully submit that the present application is in condition for allowance, early notification of which is earnestly solicited.

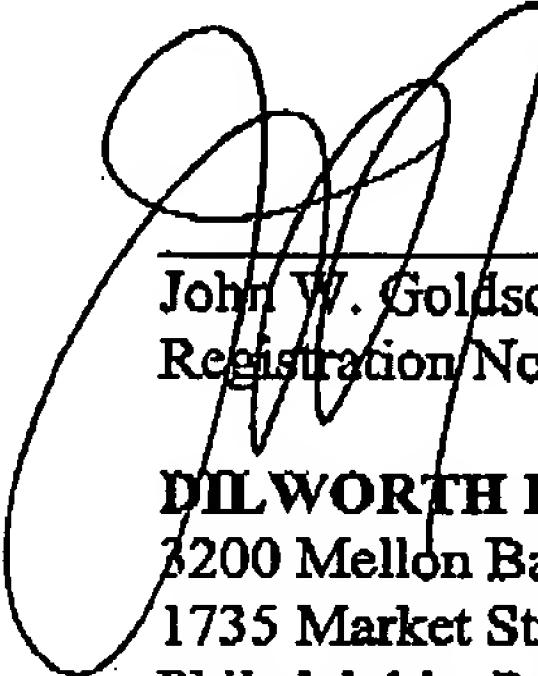
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The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment related to this submission to Deposit Account Number 50-0979.

Respectfully submitted,



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